

REMARKS

Claims 3-17, 28-31, and 38-44 are pending. In the 01 June 2005 Office Action, Claims 3-10, 13-15, 38, and 41 were rejected under 35 U.S.C. 103(a) as being unpatentable over Boden et al. (U.S. 5,930,512, hereafter Boden) in further view of Nauckhoff (U.S. 5,893,128) and in further view of Microsoft® Word 2000 (1999, hereafter Word). The above rejections of the claims 3-17, 28-31, and 38-44 are traversed, and consideration of the patentability of claims 3-17, 28-31, and 38-44, as previously presented, is requested in light of the ensuing remarks.

The Present Invention Would Not Have Been Obvious From The Cited References

A claimed invention may be found to have been obvious "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103(a). Moreover, the Federal Circuit has ruled on numerous occasions that a holding of "obviousness" requires some motivation, suggestion or teaching within the cited references that would lead one skilled in the art to modify the cited reference or references as claimed by applicant. See, for example, *In re Kotzab*, 217 F3d 1365, 55 USPQ2d 1313 (Fed Cir. 2000):

"Most if not all inventions arise from a combination of old elements. See *In re Roufflet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based

on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See *B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996)."

The cited Boden et al patent and the cited Nauckhoff patent describe software tools for Workflow processes. Word, on the other hand, is a word processing software tool that can track edits of users writing a document.

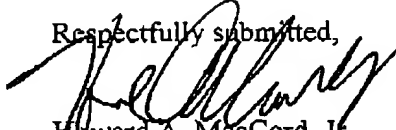
No combination of Boden, Nauckhoff and Word discloses the method of the current invention. The present invention displays visually distinctive portions of a plan as a function of frequency of change in the edit history as now reflected in the previously presented claims. In other words, Word does not provide any method of displaying how often edits are made. Word only displays that edits have been made -- without any regard to the frequency. In contrast, the present invention displays portions of a plan in a visually distinctive manner as a function of frequency of change of the edits. For example, areas of a plan that undergo the most change may be visually distinct (e.g., red or bolded or tagged with a number associated with the frequency of changes). Please see paragraph [0186] of the application.

Moreover, there is no suggestion, teaching or motivation for combining Boden and Nauckhoff with Word to come up with the present invention method of displaying portions of a plan in a visually distinctive manner as a function of frequency of change of the edits.

CONCLUSION

In view of the foregoing, claims 3-17, 28-31, and 38-44 are submitted to be allowable, so the rejections should be withdrawn.

Respectfully submitted,


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